

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

RIN 0651-AB59
[Docket No.: 2003-P-007]

For: **Notice of Proposed Rulemaking:
Changes to Implement Electronic
Maintenance of Official Patent
Application Records**

**68 Fed. Reg. 14365
(March 25, 2003)**

***Comments In Reply To the Notice of Proposed Rulemaking Regarding Changes
to Implement Electronic Maintenance of Official Patent Application Records***

Box Comments - Patents
Commissioner for Patents
Washington, DC 20231

Sir:

In reply to the Notice of Proposed Rulemaking published March 25, 2003, at 68 Fed. Reg. 14365, The PTO Practice Committee at Sterne, Kessler, Goldstein & Fox P.L.L.C. submits the following comments.

I. Proposed 37 C.F.R. § 1.9

A) At 68 FR 14374, first column, number 3, the Notice states that § 1.9 is amended "by adding paragraph (R)" However, the last part of § 1.9, as effective May 1, 2003, is "(j)." We believe the upper case "R" should be a lower case "k" and that the text should read:

"Section 1.9 is amended by adding paragraph (k)"

B) In a similar manner, in the proposed rule, there is an "(R)." The text of the proposed rule should begin with a "(k)" instead of an "(R)" as shown below:

"(k) Paper as used in this Chapter"

II. *Proposed 37 C.F.R. § 1.52(a)(1)*

The rule is being amended to apply to paper and facsimile transmissions. The current rule states that all papers, other than drawings, that are to become a part of the permanent records must be on sheets of paper that are the same size.

A) Does this "same size" requirement apply only to all papers that are part of the same pleading or literally to all papers that are filed in the same bundle under the same transmittal letter to the USPTO? For example, if the applicant files or faxes a pleading containing an amendment on A4 paper, but includes or also faxes an original executed declaration under § 1.132 or other document on letter-sized paper, must those documents be filed in two separate submissions, or one photocopied to the size of the other prior to submission, in order to comply with the rules? This seems unnecessarily harsh.

B) Must all documents filed in support of an Information Disclosure Statement, for example, all copies of the listed art, also be the same size? This also seems unnecessarily harsh.

III. *Proposed 37 C.F.R. § 1.97(c)*

At lines 5-7, the proposed § 1.97(c) recites, " . . . provided that the information disclosure statement is filed before the day of the mailing date of any of a"

We propose that the word "date" be removed so that the rule reads, " . . . provided that the information disclosure statement is filed before the day of the mailing [date] of any of a" Removing the word "date" makes the language of § 1.97(c) parallel the language of §§ 1.97(b)(3) and (4).

IV. *Proposed 37 C.F.R. § 1.121(b)(5)*

The proposed rule recites that deletion of a paragraph or section "is permitted by instruction only; no text to be canceled should be presented."

That sentence is confusing. The word "should" implies that text can be presented in certain instances. However, the phrase "permitted by instruction only" implies that the presentation of text would not be appropriate under any circumstance. It is not clear whether the phrase "permitted by instruction only" is meant to mean "permitted only by instruction."

We propose that this section be modified to clarify its meaning. We propose this section clearly indicate that presentation of some of the text that is to be deleted is allowed, if such presentation assists in determining the exact text that is to be deleted. For example, § 1.121(b)(5) might read: "Deletion of a paragraph or section is preferably by instruction only and preferably without presentation of any text that is to be canceled, unless such presentation is necessary to clearly indicate the text that is to be deleted."

It seems unduly harsh not to allow the presentation of any of the text that is to be deleted when filing an amendment to delete paragraphs or sections. Showing some of the text that is to be deleted, along with giving a location, can only help the USPTO employee who is editing the USPTO version of the application avoid making an error in determining which text it is that is to be deleted.

When entire paragraphs or sections are being deleted, it is especially important to ensure that mistakes don't happen. The applicant needs to have the flexibility to provide instructions that are as clear as possible because the applicant has no way of checking whether the person making the amendment at the USPTO has deleted the correct text until the patent issues. Sometimes, including limited amounts of text (for example, the beginning and end of the text that is to be deleted), along with the instructions as to the location, greatly clarifies what the applicant intends. To allow the applicant the flexibility of including text or not including text in such instances can only help minimize errors in the issued patent in this regard, and thus serve the public.

V. *Summary*

Consideration of the above comments is respectfully requested.

Respectfully submitted,

Sterne, Kessler, Goldstein & Fox P.L.L.C.

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